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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,459	11/13/2003	Stephen M. Floyd	031383-9088 US001	9315
23409	7590	07/05/2005		
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			EXAMINER GARTENBERG, EHUD	
			ART UNIT 3746	PAPER NUMBER
DATE MAILED: 07/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/712,459

Applicant(s)

FLOYD ET AL.

Examiner

Ehud Gartenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on papers filed through 6/13/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/13/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Notice of Allowability mailed 6/17/2005 and written 6/15/2005 is hereby withdrawn, because at the time of its issue, the Examiner was aware only of the IDS filed 6/6/2005, but he was not aware that in the meantime Applicant filed another IDS on 6/13/2005. At the time that the Examiner reviewed the application file in eDAN, on or around 6/13/2005, the other IDS filed 6/13/2005 was not yet scanned into the system, and the Examiner was unaware of it.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1, 5, 6, 10, 13, 14, and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Ishikawajima Harima JP-2203021302 (IJ in what follows) that teaches the invention as disclosed and as claimed: a micro gas turbine having a recuperator 7 wherein the exhaust gases from the recuperator can be routed either directly to an exhaust (route 8-9) or through a heat exchanger in the form of a boiler 10 to the same exhaust (route 8-8a-9a-9) according to the position of damper 26. It is noted that damper 26 may also be assigned intermediate positions, directing part of the gases directly out through the exhaust, and the remaining part of the gases through the boiler and then out through the same exhaust. Note that the direction of the flow towards the

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boiler 8-8a is opposite the direction of the flow out of the boiler 9-9a, and that damper 26 is rotated by actuator 27.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Note that at the very least the independent claims 1, 10, 18 are rejected under 35 USC 102(b) as being anticipated by Mitsubishi Heavy Industries JP-05214956 that teaches the invention as claimed: a gas turbine 1,2,3, a recuperator 4, a heat exchanger/boiler 13, a damper 12, and a common exhaust 19 from both the recuperator 4 and the heat exchanger/boiler 13.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 7-9, 11-~~13~~, 15-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over IJ for reasons discussed above, and further because the Examiner is taking Official Notice that the remaining claimed elements were conventionally used at the time of the claimed invention for their stated and intended purpose in combinations that are similar to Applicant's. In this respect, the Examiner is stating that this rejection is not a matter of finding prior art and a combination motivation

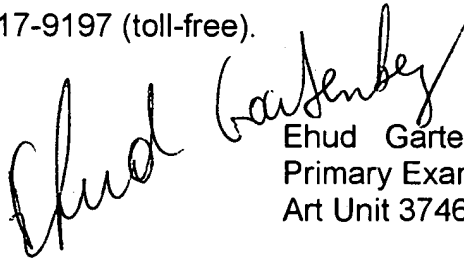
with IJ, but rather the fact that IJ did not find it necessary to teach in its application every and all details of his invention, such as a radial flow turbine that is the turbine of choice in micro gas turbines, or a finned heat-exchanger in the boiler, the finned heat-exchanger being the most conventional type of heat-exchanger, or making the control of the system responsive to the temperature of the exhaust gas out of the gas turbine - since the temperature of the heating gas and of the heated water is the only relevant parameter in this combination, see specific teaching in a similar invention by Tokyo Electric Power Company WO03/048652, paragraph 0013. Regarding the claimed hydraulic actuator, the Examiner notes that such an actuator is an obvious equivalent to shaft-actuator 27, and Applicant himself has not disclosed any criticality or particular benefit in using a hydraulic actuator for his specific invention. If Applicant disagrees with any of the statements included in this Official Notice, he is kindly asked to specifically point out in his rebuttal which aspect of his invention would not have been obvious to be combined with the IJ invention, and where the criticality of said element was disclosed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ehud Gartenberg whose telephone number is 571 272 4828. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Thorpe can be reached on 571 272 4444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ehud Gartenberg  
Primary Examiner  
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06292005